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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,209	06/22/2001	Yuko Tachibana	209663USPCT	6187

22850 7590 11/17/2003

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EXAMINER

PIZIALI, ANDREW T

ART UNIT PAPER NUMBER

1775

DATE MAILED: 11/17/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

00019

# Advisory Action

Application No.

09/857,209

Applicant(s)

TACHIBANA ET AL.

Examiner

Andrew T Piziali

Art Unit

1775

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 2,4,6-9,11-18 and 22-30.

Claim(s) withdrawn from consideration: 19-21.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☒ Other: See Continuation Sheet

SUPERVISORY PATENT EXAMINER

## Continuation of 2. NOTE:

The issues raised by amending claim 11 to include the limitation that the laminate contains at least two metal layers would require further consideration and/or search. The issues raised by amending dependent claims 13 and 15 to depend on new claim 11 would require further consideration and/or search.

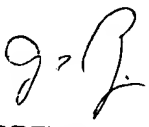
## Continuation of 5. does NOT place the application in condition for allowance because:

Due to the proposed amendment not being entered, applicant's arguments are not commensurate in scope with the current claims.

## Continuation of 10. Other:

Answer to restriction arguments with traverse: Applicant's election with traverse is acknowledged. The traversal is on the grounds that the examiner has not made out a case of lack of unity of invention. The examiner respectfully disagrees.

The species do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical feature for the following reason: In the amendment filed 7/24/2003 the applicant showed that at least one Markush alternative is not novel over the prior art by amending the Markush Group to overcome the prior art teaching of laminate comprising an interlayer of silicon oxide or aluminum oxide. MPEP 1850(D) states "When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention shall be reconsidered by the examiner." Therefore, upon reconsideration, it is the position of the examiner that since at least one alternative is not novel over the prior art the species lack the same or corresponding special technical feature. The requirement is still deemed proper and is therefore made FINAL.

  
**ANDREW T. PIZIALI**  
**PATENT EXAMINER**